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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/890,330 | 07/30/2001 | Akira Fukunaga | FUKUNAGA=5 | 9513 |

1444 7590 08/29/2003

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EXAMINER

LEE, CALVIN

ART UNIT PAPER NUMBER

2825

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,330

Applicant(s)

FUKUNAGA ET AL.

Examiner

Lee Calvin

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

OFFICE ACTION

Election/Restriction

1. Claims 1-15 are pending in this application.

Restriction to one of the following inventions is required under *35 U.S.C. 121*:

- (I) Claims 9-15, drawn to an apparatus for forming a metal film, classified in class 118, subclass 244 (or 725).

- (II) Claims 1-8, drawn to a film forming method, classified in class 438, subclass 679.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product made and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the product as claimed can be used to make other and materially different process or (2) that the process as claimed can be made by another and materially different product (MPEP § 806.05(f)). In the instant case, unpatentability of the group I invention would not necessarily imply unpatentability of the group II invention, since the device of the group I invention could be made by a process materially different than that of the group II invention.

For example, a film forming apparatus can be used not only for forming a film but also for coating a semiconductor layer, heating/evaporating a solvent dissolved in the layer, and polishing/cleaning the layer's surface.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the fields of search are not coextensive. Therefore, separate examination would be required and restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement is traversed (37CFR 1.143)

Contact Information

4. Any inquiry concerning this communication from the examiner should be directed to *Calvin Lee* at (703) 306-5854 from 7:00 to 17:00 (Monday-Thursday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor *Matthew Smith* can be reached at (703) 308-1323.

Any inquiry relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1782. The fax phones are (703) 872-9318 for regular communications and (703) 872-9319 for After-Final communications.



Calvin Lee

Patent Examiner